

REMARKS/ARGUMENTS

Drawings

The documents submitted by the Examining Attorney show an objection to the drawings in that item 20a is missing from a Figure. The Applicant is submitting as part of the Appendix, an "Annotated Sheet Showing Changes", in addition to the "Replacement Sheet", to make the amendment to the drawings and thereby removing the rejection. Figure 3 is being amended to include reference number 20a.

Anticipation - Section 102(b) Rejection

The Examining Attorney has rejected claims 1 through 5 and 7 as being anticipated by Rodriguez et al. The Applicant respectfully requests the Examining Attorney reconsider the rejection based on the arguments set forth below, and in light of the amendments to the claims set forth above.

The applicant submits that Rodriguez et al. does not anticipate this invention because Rodriguez et al. reference does not disclose each and every element of the claimed invention for claims 1, 6, and 7, as required for a *prima facie* case of anticipation, and as stated more fully above. Rodriguez et al. does not disclose the newly added elements of claims 1, 6 or 7. There is no anticipation if the reference does not disclose each and every element of the

claimed invention. SSIH Equipment S.A. v. United States International Trade Commission, 718 F.2d 365, 218 U.S.P.Q. 678 (1983).

Claim 5 depends on claim 1 and is allowable for the same reasons.

Obviousness - Section 103(a) Rejection

The Examiner has rejected claim 6 under Section 103(a) as being obvious. The Applicant respectfully requests the Examiner reconsider the rejection based on the claim amendment, and because there is nothing in the Rodriguez et al. reference which suggests or teaches to have a first length and a second length, nor to provide a connector between the wear inserts.

Furthermore, there is nothing in the Rodriguez et al. reference which suggests the desirability of the combination and therefore the Examiner has not met the minimum required showing for *prima facie* obviousness.

In the U.S. Court of Appeals for the Federal Circuit case of *In Re: Lee*, 61 U.S.P.Q. 2d 1430, decided January 18, 2002, the Federal Circuit held:

... Thus, when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The Board cannot rely on conclusory statements when dealing with particular combinations

of prior art and specific claims, but must set forth the rationale on which it relies.

The examining attorney has therefore failed to meet the requirement to set forth with specificity the general knowledge in the art to enable a finding that the person having ordinary skill in the art would make such combination.

As the PTO recognizes in MPEP 2142:

The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process.... The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness: If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of non-obviousness.... The initial evaluation of *prima facie* obviousness thus relieves both the Examiner and Applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to suggest the claimed invention.

MPEP 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also

suggests the desirability of the combination. *In re: Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

The Federal Circuit has several times expressly addressed the issue of how to evaluate an alleged case of *prima facie* obviousness to determine whether it has been properly made. Thus, *In re: Geiger* stated in holding that the PTO "failed to establish a *prima facie* case of obviousness:

Obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ADC Hospital Systems, Inc. V. Monteffore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Double Patenting

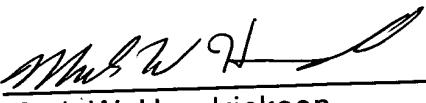
The Applicant notes the nonstatutory double patenting rejection made by the Examiner. In light of the amendments and the arguments submitted herein, the Applicant respectfully requests that the examiner hold this rejection in abeyance until allowable subject matter has been determined.

Conclusion

Applicant therefore submits Claims 1, 5-9 are in a position to proceed to allowance.

Respectfully submitted,

Dated: 9-27-04

By: 
Mark W. Hendricksen
Reg. No. 32,356

Attachments: Replacement Sheet (For Sheet 3 of 8, Figures 3 & 4)
Annotated Sheet Showing Changes (For Sheet 3 of 8, Figures
3 and 4)

Amendment to the Drawings:

The attached sheet of drawings includes changes to Figure 3. This sheet replaces the original sheet. In Figure 3, item 20a has been added. Applicant hereby requests that said proposed amendments be approved and accepted.



3/8

